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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,334	11/10/2003	Miguel A. Zubizarreta	685665600010	5082
Paul E. Franz Jones Day North Point 901 Lakeside Avenue Cleveland, OH 44114			EXAMINER VEZERIS, JAMES A	
			ART UNIT 3693	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/705,334

**Applicant(s)**

ZUBIZARRETA, MIGUEL A.

**Examiner**

JAMES A. VEZERIS

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

***Detailed Action***

***Response to Applicant's Amendment***

1. Examiner acknowledges the amendment to the abstract and withdraws all previous objections.
2. Examiner acknowledges the cancellation of claims 2 and 3. Claims 1, 4-26 remain pending.
3. Examiner removes the 112 2nd paragraph rejection on claim 3 due to the cancellation of the claim.
4. Applicant's arguments with respect to claims 1, 4-27 have been considered but are moot in view of the new ground(s) of rejection.
5. In regard to applicant's argument that claim 7 is not taught in the original rejection, examiner disagrees. Shift teaches storing all the images in an archive (first sorting) and also allowing banks to retrieve them (secondary sorting). A new rejection in light of the applicant's amendment is included below.

***Claim Rejections- 35 U.S.C. 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 4-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A Shift In Check Clearing And Settlement Technology" in view of US Patent 5,930,778 to Geer. (Hereinafter "Geer")

***Regarding Claim 1, 15, 17, 19, and 27:***

Shift teaches a computer-implemented method for the sorting of check files and facilitating the direct distribution of the check files to multiple endpoints, comprising:

Receiving an unsorted check file comprising check images and related check data. (See section titled "Cutting the Check")

Processing the unsorted check files to create sorted check images and related

check data in separate sorted check files. (See section titled "Cutting the Check")

Associating a sorted check file with a corresponding endpoint. (See section titled "Cutting the Check")

Directly distributing the sorted check files to their corresponding endpoints for presentment for payment from the image and related data. (See section titled "Cutting the Check")

Shift fails to teach the receiving, processing, associating, and directly distributing processes are performed by a bank that captures check images of checks the bank has acceptor for deposit.

Geer teaches the receiving, processing, associating, and directly distributing processes are performed by a bank that captures check images of checks the bank has acceptor for deposit. (See figure 1, col 7)

It would be obvious to combine Geer and Shift. There is motivation to do so because, the outsourcing of the work from the bank to a third party potentially saves time and money for the bank.

Claims 15, 17, and 19 are rejected for analogous reasoning.

***Regarding Claim 2:***

Shift further teaches the receiving, processing, associating, and directly distributing processes are performed by a bank that captures check images of checks the bank has accepted for deposit. (See section titled "Cutting the Check")

***Regarding Claim 3:***

Shift further teaches a first bank captures check images of checks the first bank has accepted for deposit, and a second bank performs the receiving, processing, associating, and directly distributing processes. (See section titled "Cutting the Check") Examiner notes second bank can be a bank clearing house.

***Regarding Claim 4:***

Shift further teaches the unsorted check file is provided by an entity that has received payment checks and has captured the check images in the check image file. (See section titled "Cutting the Check")

***Regarding Claim 5:***

Shift further teaches the endpoints correspond to one or more banks. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 6:***

Shift further teaches:

Associating a primary endpoint with a plurality of endpoints. (See section titled "Cutting the Check")

Directly distributing the sorted check files according to the primary endpoint. (See section titled "Cutting the Check")

***Regarding Claim 7:***

Shift further teaches:

A first sorting of the check images and related check image data according to the

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primary endpoints. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

A second sorting of the check images and related check image data according to the plurality of endpoints associated with the primary endpoint. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

Examiner also notes a first sorting and second sorting are taught in Geer as can be seen in figure 1. Checks go to a check payee account as well as an archive of electronic images.

***Regarding Claim 8:***

Shift further teaches the endpoints are ABA numbers. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 9:***

Shift further teaches the directly distributing process comprises a timed batch transmission of sorted check files to an electronic address associated with an endpoint. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing") Examiner notes the sending of information at any time can constitute a timed batch.

***Regarding Claim 10:***

Shift further teaches the sorted check files conform to one or more electronic payment standards. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 11:***

The method of Claim 1 further comprising distributing one or more sorted check files to a Federal Reserve Bank. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 12:***

Shift further teaches storing the cumulative value of the checks transmitted in a sorted check file and the endpoint to which the sorted check file is transmitted in a reconciliation database. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing" and third paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 13:***

Shift further teaches storing the cumulative value of the checks received in the unsorted check file and an endpoint from which the unsorted check file is received in the reconciliation database. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 14:***

Shift further teaches generating a report that reconciles a clearing of outbound checks versus inbound checks for an endpoint. (See Last paragraph of section titled



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"Just as Electronic Check Volume is Increasing" and second and third paragraphs of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 16:***

Shift further teaches instructions operable to cause one or more computers upon execution by the one or more computers to directly distribute the sorted check files to their corresponding endpoint for presentment for payment from the image and related data. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 18:***

Shift further teaches means for causing one or more computers to perform the operation of directly distributing the sorted check files to their corresponding endpoints for presentment for payment from the image and related data. (See section titled "Cutting the Check" and last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 20:***

Shift further teaches the sorting database comprises a data record structure stored in a computer readable medium, the data structure comprising an ABA number field, an account number field, an endpoint number field, and a primary ABA field. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 21:***

Shift further teaches the ABA number field in a first data record structure may be associated with a primary ABA field in a second data record structure. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 22:***

Shift further teaches:

a direct distribution computer system comprising a processing system and a memory system, the memory system storing processing instructions operable to cause the processing system to receive the separate sorted check files and directly distribute the separate sorted check files to institutions associated with the corresponding endpoints of the separate sorted check files. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 23:***

Shift further teaches the sorting database comprises a data record structure stored in a computer readable medium, the data structure comprising an ABA number field, an account number field, an endpoint number field, and a primary ABA field, and wherein the ABA number field in a first data record structure may be associated with a primary ABA field in a second data record structure. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 24:***

Shift further teaches the direct distribution computer system is operable to directly distribute the separate sorted check files to institutions associated with the primary ABA field. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second paragraph of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange" and second and third paragraphs of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

***Regarding Claim 25:***

Shift further teaches the sorting computer system and the direct distribution computer system comprise a single computer system. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing")

***Regarding Claim 26:***

Shift further teaches the sorting computer system and the direct distribution computer system comprise a plurality of computer systems in communication over a computer network. (See Last paragraph of section titled "Just as Electronic Check Volume is Increasing" and second and third paragraphs of section titled "Leveraging Prime Pass Image Capture for Check Image Exchange")

**Other Potential Art**

4. US Patent 6,996,263 to Jones et al. "Network Interconnected Financial Document Processing Devices" filed Jan. 9, 2002.

5. Public Law 108-100, "Check Clearing for the 21<sup>st</sup> Century Act" found @  
"http://frwebgate.access.gpo.gov/cgi-bin/getdoc.cgi?dbname=108\_cong\_public\_laws&docid=f:publ100.108.pdf"

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JAMES A. VEZERIS** whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/  
Examiner, Art Unit 3693

7/15/2008